

In this response, Applicants traverse the §102(b) and §103(a) rejections. Applicants respectfully request reconsideration of the present application in view of the following remarks.

Applicants initially note that the Ito and Ohtsuka references are not prior art relative to the present application. As indicated above, the present application claims the priority of U.S. Patent Application Serial No. 08/977,382 filed November 24, 1997, which claims the priority of U.S. Provisional Application Serial No. 60/037,963 filed February 20, 1997.

The Ito reference was filed July 8, 1998, and is therefore not prior art relative to the present application.

The Ohtsuka reference was filed September 10, 1998, and is therefore not prior art relative to the present application.

In view of the fact that the Ito and Ohtsuka references are not prior art relative to the present application, the §103(a) rejections are believed to be improper and should be withdrawn. Claims 3, 4, 7, 8, 11, 12, 15 and 16 should thus be indicated as containing allowable subject matter.

With regard to the §102(b) rejection, Applicants traverse the rejection on the ground that Sarbadhikari et al. does not disclose at least the claimed print utilization file as set forth in independent claims 1 and 10. The Examiner in the §102(b) rejection argues that the claimed print utilization file is disclosed by the teachings in column 4, lines 37-42 of Sarbadhikari et al. This portion of Sarbadhikari et al. states as follows, with emphasis supplied:

The invention is based on the recognition that the storage device, i.e., the memory card 3 in FIG. 1, need not be primarily oriented to storage of data for downstream (i.e., computer) processing. The storage device may additionally contain files (data, code, etc.) which are capable of upstream modification of image data and camera performance.

The Examiner asserts that, because the memory card 3 can contain at least two data files, Sarbadhikari et al. discloses the claimed print utilization file (Office Action, page 10, section 6). Applicants respectfully disagree. The claimed print utilization file identifies "at least two digital image files . . . to be printed" as set forth in claims 1 and 10. Moreover, these claims specifically require that the "at least two

digital image files” associated with the claimed print utilization file correspond to selected ones of a plurality of digital images captured by a digital camera adapted to receive the removable memory card.

The data files referred to in column 4, lines 37-42 of Sarbadhikari et al. simply do not meet these limitations. The memory card 3 of Sarbadhikari et al. is insertable into the electronic camera 1 of FIG. 1, and may be used to store images captured by the electronic camera 1, as indicated in column 4, lines 2-9. However, there is no print utilization file as claimed that is stored on memory card 3. The data files referred to by the Examiner with reference to column 4, lines 37-42 are specifically described in Sarbadhikari et al. as being used for “upstream modification of image data and camera performance,” and therefore do not teach or suggest the claimed print utilization file.

Applicants thus submit that there is no teaching or suggestion in Sarbadhikari et al. regarding a print utilization file identifying at least two digital image files to be printed, where the identified files correspond to selected images captured by a digital camera adapted to receive the removable memory card.

Applicants note that MPEP §2131 specifies that a given claim is anticipated “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the “identical invention . . . in as complete detail as is contained in the . . . claim,” citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). For the reasons identified above, Applicants submit that the Examiner has failed to establish anticipation of at least independent claims 1 and 10 by the Sarbadhikari et al. reference. The §102(b) rejection is therefore believed to be improper and should be withdrawn.

Dependent claims 2-9 and 11-17 are believed allowable for at least the reasons identified above with regard to their corresponding independent claims.

Accordingly, this application is believed to be in condition for allowance, the notice of which is respectfully requested.

Respectfully submitted,

Pamela R. Crocker
Attorney for Applicants
Registration No. 42,447

Pamela R. Crocker/phw
Rochester, NY 14650
Telephone: (585) 477-0553
Facsimile: (585) 477-4646